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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,797	10/19/2001	Jen-Hwang Weng	BHT-3167-22	6951
7590 11/08/2005 DOUGHERTY & TROXELL 5205 LEESBURG PIKE, SUITE 1404 FALLS CHURCH, VA 22041			EXAMINER RIES, LAURIE ANNE	
			ART UNIT 2176	PAPER NUMBER
DATE MAILED: 11/08/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/981,797	WENG, JEN-HWANG	
	Examiner	Art Unit	
	Laurie Ries	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment, filed 25 August 2005, to the original application filed 19 October 2001.
2. Claims 1-3, 5-12, and 14 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Sidana (U.S. Patent 6,571,295 B1) in view of Boys (U.S. Patent 6,516,340 B2).
3. Claims 1-3, 5-12 and 14 are pending. Claims 4 and 13 have been cancelled. Claims 1 and 8 are independent claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-3, 5-12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sidana (U.S. Patent 6,571,295 B1) in view of Boys (U.S. Patent 6,516,340 B2).

As per claims 1 and 8, Sidana discloses a system and method for providing online web page annotations, or reading records, allowing a number of users to process annotations, or reading records, including displaying a web page and related annotations, or reading records, in a browser of an end user, the related annotations, or reading records, distinguished by the end user's identification data (See Sidana, Column 11, Claim 11, and Column 12, Claim 14), receiving annotations, or reading records, entered by the end users through the annotation, or reading record, function on the web page (See Sidana, Figure 7, and Column 7, lines 13-41), and storing the users' identification information and related annotated web pages (See Sidana, Column 12, Claim 14). Sidana does not disclose expressly providing a number of annotation, or reading record, functions on the web page and instantly displaying the annotations, or reading records, on the web page. Boys discloses annotation tools, equivalent to reading record functions (See Boys, Column 6, lines 34-43). Boys also discloses displaying the annotations on the web page (See Boys, Column 8, lines 22-24). Sidana and Boys are analogous art because they are from the same field of endeavor of annotating or modifying the contents of web documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the annotation tools and instant display of modified web pages of Boys with the system and method of processing documents of Sidana. The motivation for doing so would have been to

enhance and store selected web pages and to provide the content to users (See Boys, Column 2, lines 42-53). Therefore, it would have been obvious to combine Boys and Sidana for the benefit of enhancing and storing selected web pages and providing the content to users to obtain the invention as specified in claims 1 and 8.

As per claims 2 and 9, Sidana and Boys disclose the limitations of claims 1 and 8 as described above. Sidana also discloses that the annotation, or reading record, functions allows the end user to insert a web page object on the web page and immediately display an inserted object on the page by making the related HTML code of the web page object insert the inserted object in a selected location in real time (See Sidana, Column 6, lines 56-67, and Column 7, lines 1-7).

As per claims 3 and 10, Sidana and Boys disclose the limitations of claims 1 and 8 as described above. Sidana also discloses that the annotation, or reading record, functions provides a means for the end user to change the format attributes of a selected portion on the web page and the web page will immediately display the changed format on the selected portion by replacing the selected portion with the related HTML codes in real time on the web page (See Sidana, Column 12, Claim 21, Column 10, lines 58-67, and Column 11, lines 1-4).

As per claims 5 and 11, Sidana and Boys disclose the limitations of claims 2 and 9 as described above. Sidana also discloses that the inserted object can be a text object (See Sidana, Figure 7, element 712) or a hyperlink object linking to a selected address (See Sidana, Column 11, lines 1-10, Column 7, lines 59-67, and Column 8, lines 1-34), which are two of the possible types presented in claims 5 and 11.

As per claims 6 and 12, Sidana and Boys disclose the limitations of claims 3 and 10 as described above. Boys also discloses that the functions required to change format attributes or its displayed characteristics to the portion of the web page include adding underline on a selected text, or masking a selected visible object (See Boys, Column 6, lines 34-43). Sidana and Boys are analogous art because they are from the same field of endeavor of annotating or modifying the contents of web documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the underlining of selected text of Boys with the system and method of processing documents of Sidana. The motivation for doing so would have been to enhance selected web pages and to provide the updated content to users (See Boys, Column 2, lines 42-53). Therefore, it would have been obvious to combine Boys and Sidana for the benefit of enhancing selected web pages and providing the updated content to users to obtain the invention as specified in claims 6 and 12.

As per claims 7 and 14, Sidana and Boys disclose the limitations of claims 1 and 8 as described above. Boys also discloses that the web pages contains education materials (See Boys, Column 1, lines 51-67, and Column 2, lines 1-5). Sidana and Boys are analogous art because they are from the same field of endeavor of annotating or modifying the contents of web documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the educational material of Boys with the system and method of processing documents of Sidana. The motivation for doing so would have been to allow educational providers to prepare lectures and the like from existing Web sources and package them for timed execution such that a

number of students may learn on-line according to a predetermined schedule, and, in some cases, in real time (See Boys, Column 2, lines 6-12) Therefore, it would have been obvious to combine Boys and Sidana for the benefit of allowing educational providers to prepare lectures and the like from existing Web sources and package them for viewing by students to obtain the invention as specified in claims 7 and 14.

Response to Arguments

5. Applicant's arguments filed 25 August 2005 have been fully considered but they are not persuasive.

Regarding Applicant's argument on Page 3 of the Instant Amendment stating that Sidana combined with Boys fail to teach providing a plurality of reading records functions on the web page, the Office respectfully disagrees. Boys teaches providing a number of annotation tools, equivalent in functionality to the reading record functions of the Instant Application (See Boys, Column 6, lines 34-43). The annotation tools of Boys allows for the display of the annotations instantly on the web page (See Boys, Column 8, lines 22-24). While Applicant states that displaying the reading records on the web page without modifying the HTML via the redirector is not taught by Sidana or Boys, this limitation is not included in the claim language.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine Boys with Sidana would be to enhance and store selected web pages and to provide the content to the users.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (571) 272-4136.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
11/4/2005